

Remarks/Arguments:

Amendments

There are no amendments.

Restriction Requirement

Applicants affirm the election of claims 1-10.

Rejection under 35 U.S.C. ¶ 112, second paragraph

Claims 8-10 were rejected under 35 U.S.C. ¶ 112, second paragraph. Specifically, it was alleged that it was not clear what "P" stands for. This rejection is respectfully traversed.

It is respectfully pointed out that "P" appears in claims 8 and 9, but not in claim 10, which is dependent on claim 5.

A decision on whether a claim is invalid under Section 112, second paragraph, requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986) (citing cases).

The meaning of "P" in claims 8-10 is well known to those skilled in the art. "P" is a prefix that indicates *para-*, or 1,4-substitution of two substituents on a benzene ring. Copies of pages, which show the meaning of *p-* or *para-*, from the following are enclosed: The Condensed Chemical Dictionary, 9th Ed., Van Nostrand and Reinhold, New York, 1977, p. 649; Organic Chemistry, R.T. Morrison and R.N. Boyd, Allyn and Bacon, Boston, 1959, p. 234; and Basic Principles of Organic Chemistry, J.D. Roberts and M.C. Caserio, W.A. Benjamin, New York, 1965, p. 769. It is submitted that this rejection should be withdrawn.

Rejection Under 35 U.S.C. ¶ 102(e)

Claims 1-7 were rejected as anticipated by Tao, U.S. Published Application 2005/0008965 ("Tao"). This rejection is respectfully traversed.

The Office asserts that Tao discloses a printing plate precursor comprising a substrate and an imageable coating on the substrate, wherein the imageable coating comprises a sulfated phenolic resin. However, as used in Tao, "sulfated phenolic resin" is defined as follows:

As used herein, the phrase "sulfated phenolic resin" means a phenolic resin modified to have sulfate ($-\text{OSO}_3^-$) moieties attached to aromatic rings of the polymer backbone, in place of hydroxy substituents, for at least some of the repeating units of the polymer. The sulfate moieties may be in acid form ($-\text{OSO}_3\text{H}$), or in salt form with a corresponding counterion X^+ ($-\text{OSO}_3^- \text{X}^+$). The units comprising sulfate moieties will generally be randomly interspersed among the repeating units of the resin. However, the units comprising sulfate moieties may also be distributed in a more orderly fashion, such as in a segmented polymer or a block copolymer.

Tao, ¶ [0034] (emphasis added).

Structures A and B in column 4, ¶ [0041], of Tao show the sulfate moieties attached to aromatic rings of the polymer backbone.

Tao's definition of "sulfated phenolic resin" is limited to phenolic resins modified to have sulfate moieties attached to aromatic rings of the polymer backbone. It does not include sulfated phenolic resins in which the sulfate moiety is attached to aromatic rings that are not part of the polymer backbone or in which the sulfate moiety is attached to an alkyl group. Claim 1 of the instant application, on which claims 2-10 directly or indirectly depend, recites that "the sulfate groups are attached to aryl groups that are pendent to the polymer backbone, to alkyl groups, or both to aryl groups that are pendent to the polymer backbone and to alkyl groups."

Anticipation requires that each and every limitation of the claim be disclosed, either expressly or under principles of inherency, in a single prior art reference. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Absence from the reference of any claimed limitation negates anticipation. *Rowe v. Dror*, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). Tao does not disclose imageable elements in which the imageable composition comprises a sulfated polymer comprising sulfate groups attached to aryl groups that are pendent to the

polymer backbone, to alkyl groups, or both to aryl groups that are pendent to the polymer backbone and to alkyl groups. Therefore, the rejection of claims 1-7 as anticipated by Tao should be withdrawn.

As the Office points out, U.S. Published Application 2005/0008965 and the instant application have common inventors. Further, U.S. Published Application 2005/0008965 and the subject matter of the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Therefore, Tao is not available as a reference under 35 USC 103/102(e).

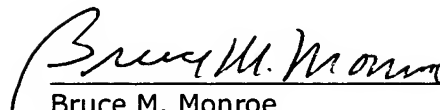
Conclusion

It is respectfully submitted that the claims are in condition for immediate allowance and a notice to this effect is earnestly solicited. The Examiner is invited to phone applicants' attorney if it is believed that a telephonic or personal interview would expedite prosecution of the application.

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KPG-5094US

Respectfully submitted,



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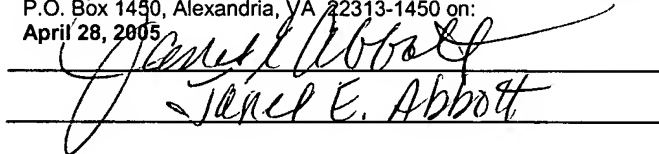
Dated: April 28, 2005

Enclosures: The Condensed Chemical Dictionary, p. 649
Organic Chemistry, p. 234
Basic Principles of Organic Chemistry, p. 769

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James E. Abbott

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